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THE UNITED STATES PATENT
AND TRADEMARK OFFICE

Patent No. : 7,230,023

Issue Date : June 12, 2007

Serial No. : 10/647,023

Applicants : Makoto MORI et al.

Filed : August 20, 2003

For : WATER-SOLUBLE TRIAZOLE
FUNGICIDE

Art Unit : 1626

Examiner : Janet L. COPPINS

Docket No. : 03445CIP/HG

Confirm. No.: 1541

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Commissioner for Patents,
P.O. Box 1450
Alexandria, VA 22313-1450

Dorothy DeFrancesco
Dorothy DeFrancesco

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Account No. 06-1378.

APPLICATION FOR PATENT TERM ADJUSTMENT INCLUDING
REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
INDICATED IN AN ISSUED PATENT (37 CFR §1.705(d))

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

MAIL STOP PETITION

S I R :

1. This is a request for reconsideration of the patent term adjustment of 585 days indicated in the above-identified issued patent. It is respectfully requested that applicants be afforded

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a patent term adjustment of 881 days, i.e., an additional 296 days of patent term adjustment.

2. A PETITION FOR SUSPENSION OF RULES UNDER 37 CFR §1.183 is being filed herewith to request suspension of the two-month term set forth in 37 CFR §1.705(d) for filing an application for patent term adjustment within two months of the issue date.

3. Applicants submit herewith a "Statement of the Correct Patent Term Adjustment: Basis Under 37 CFR §1.702 For the Adjustment (37 CFR §1.705(b)(2)(i) and (ii))."

4. The above-identified patent is not subject to a terminal disclaimer (37 CFR §1.705(b)(2)(iii)).

5. As to any circumstances during the prosecution of this patent constituting a failure to engage in reasonable efforts to conclude processing or examination of the above-identified patent as set forth in §1.704 (37 CFR §1.705(b)(2)(iv)): there was none (37 CFR §1.705(b)(2)(iv)(B)).

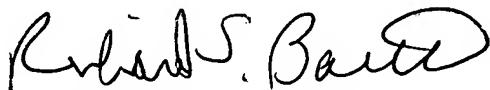
6. The fee set forth in 37 CFR §1.18(e) (\$200), required by 37 CFR §1.705(b)(1), is paid as follows:

Attached is a Form PTO-2038 in the amount of \$200.

To the extent not tendered by Form PTO-2038 attached hereto, authorization is given to charge any additional fees to Deposit Account No. 06-1378.

It is respectfully requested that this application for patent term adjustment be granted and that a Certificate of Correction be issued to indicate a patent term adjustment of 881 days.

Respectfully submitted,


RICHARD S. BARTH

RICHARD S. BARTH

REG. NO. 28,180

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RSB/ddf

Encs.: (1) Statement of the Correct Patent Term Adjustment:
Basis Under 37 CFR §1.702 For the Adjustment (37 CFR
§1.705(b)(2)(i) and (ii))

(2) Form PTO-2038



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**STATEMENT OF THE CORRECT PATENT TERM ADJUSTMENT:
BASIS UNDER 37 CFR §1.702 FOR THE ADJUSTMENT
(37 CFR §1.705(b)(2)(i) AND (ii))**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

MAIL STOP PETITION

S I R :

1. This statement is being submitted in support of the "APPLICATION FOR PATENT TERM ADJUSTMENT INCLUDING REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT INDICATED IN AN ISSUED PATENT (37 CFR §1.705(d))" to which this statement is attached.

37 CFR §1.705(b)(2)(i)

2. The patent term adjustment indicated in the above-identified patent is 585 days. It is respectfully submitted that such indication of patent term adjustment is in error. The error is that the indication of patent term adjustment included only the USPTO delay afforded by 37 CFR §1.702(a) (35 U.S.C. §154(b)(1)(A)), but did not include the USPTO delay afforded by 37 CFR §1.702(b) (35 U.S.C. §154(b)(1)(B)) of 296 days.

It is respectfully submitted that the correct patent term adjustment under 37 CFR §1.702 is 881 days, i.e., 585 days plus 296 days.

37 CFR §1.705(b)(2)(ii)

3. The basis on which applicants seek adjustment is as follows:

In addition to the 585 days of patent term adjustment afforded the applicants pursuant to 37 CFR §1.703(a) (35 U.S.C. §154(b)(1)(A)) 37 CFR §1.703(a) ("Examination Delay," "Administration Delay," "A Delay" or "A Period"), applicants respectfully request to be entitled to a period of patent term adjustment due to the failure of the USPTO to issue a patent within three years after the date the application was filed on August 20, 2003 pursuant to 37 CFR §1.703(b) (35 U.S.C. §154(b)(1)(B)) ("Three Year Delay," "B Period" or "B Delay").

As shown in the following calculation, the "B Period" is 296 days.

a. Beginning of the 37 CFR §1.702(b) (35 U.S.C. §154(b)(1)(B)) Period ("B Period"): August 20, 2006

Three years after the filing of the above-identified application on August 20, 2003 is August 20, 2006.

b. End of the 37 CFR §1.702(b) (35 U.S.C. §154(b)(1)(B)) period ("B Period"): June 12, 2007.

The issue date of the above-identified patent is June 12, 2007.

c. Duration of the "B Period": 296 days

The period from August 20, 2006 to June 12, 2007 is 296 days.

d. Possible Overlap of USPTO Delay Periods

Overlap of PTA of the "A Period" and the "B Period": 0 days.

e. Additional days of PTA requested herein: 296 days.

The above calculation is shown schematically in the attached Exhibit A.

Applicants request herein that they are entitled to a patent term corresponding to the "A Period" + the "B Period" (minus any overlap) is consistent with the Court's decision in Wyeth v. Dudas, 88 USPQ 2d 1538 (D.D.C. 2008). The Wyeth v. Dudas decision explained the proper method for calculating patent term adjustment under 37 CFR §1.702 and 35 U.S.C. §154(b).

Respectfully submitted,



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RSB/ddf

Enclosure: Exhibit A

Exhibit A

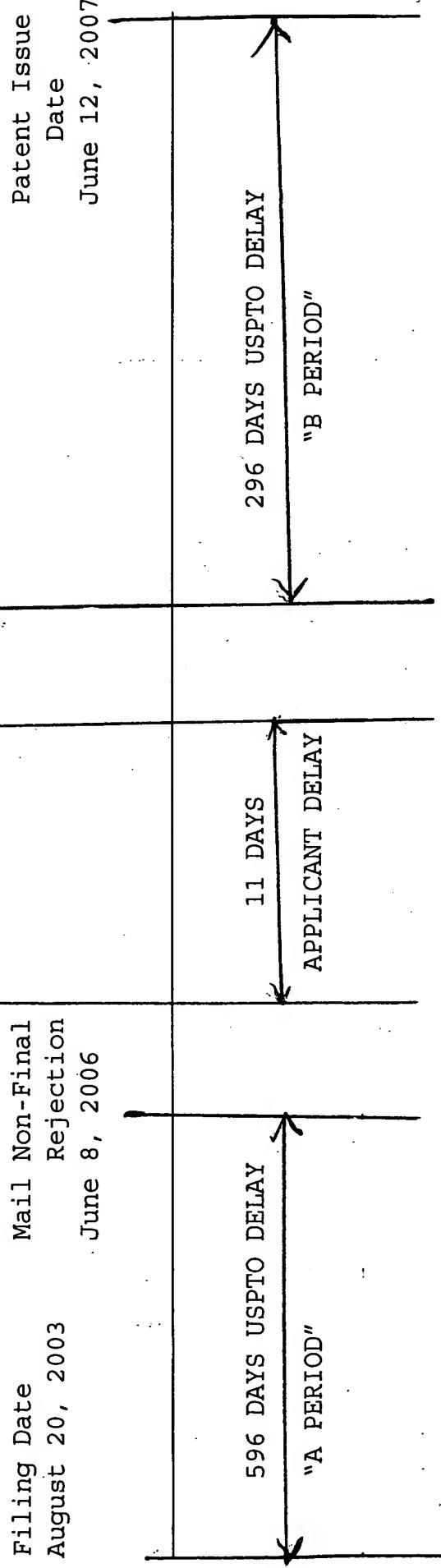
Supplemental
Response to Restriction
Requirement
July 18, 2006

Response to

Restriction Requirement

July 7, 2006

Three Years from
Filing - August 20, 2006



$$PTA = A \text{ PERIOD} + B \text{ PERIOD} - \text{APPLICANT DELAY}$$

$$= 596 \text{ days} + 296 \text{ days} - 11 \text{ days}$$

$$= 881 \text{ days}$$



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**PETITION FOR SUSPENSION OF RULES
UNDER 37 CFR §1.183**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

MAIL STOP PETITION

S I R :

To have the USPTO consider the application for patent term
adjustment that is being filed concomitantly herewith, applicants
hereby petition under 37 CFR §1.183 to suspend the provision set
forth in 37 CFR §1.705(d), which requires that "any request for
reconsideration of the patent term adjustment indicated in the

patent must be filed within two months of the date the patent issues."

A. Summary

As will be explained in detail hereinbelow, this Petition addresses an extraordinary situation, which justice and equity require suspension of a provision of a Patent Rule, namely 37 CFR §1.705(d).

The extraordinary situation arises from the fact that the USPTO determination of patent term adjustment for the above-identified patent was based on an interpretation by the USPTO of provisions of the Patent Rules (37 CFR §1.702(a), 37 CFR §1.702(b) and 37 CFR §1.703(f)) and provisions of the Patent Statute (35 U.S.C. §154(b)(1)(A), 35 U.S.C. §154(b)(1)(B) and 35 U.S.C. §154(b)(2)(A)) that was published in 69 Fed. Reg. 34238 (June 21, 2004). Such USPTO interpretation was found to be incorrect in a decision of a United States District Court (i.e., Wyeth v. Dudas, 88 USPQ 2d 1538 (D.D.C. 2008)).

Applicants, by relying on the aforesaid USPTO interpretation, lost the right to request additional patent term adjustment for a valuable patent. In particular, because applicants followed such incorrect USPTO interpretation of provisions of the Patent Rules and the Patent Statute, the term of applicants' patent has potentially been substantially

shortened. The injustice suffered by the applicants can be remedied only if the USPTO grants this petition, so that applicants can request that the USPTO reconsider their patent term adjustment in light of the Wyeth v. Dudas decision.

If applicants are deprived of the relief sought herein, applicants will be discriminated against because applicants followed the USPTO interpretation set forth in 69 Fed. Reg. 34238 (June 21, 2004). It is an extraordinary situation that the aforesaid USPTO interpretation was revised in the Wyeth v. Dudas decision.

In view of the timing of the issuance of applicants' patent and the rendering of the Wyeth v. Dudas decision, applicants can no longer seek a court review of this matter. Thus, applicants' sole possibility to obtain relief is for the USPTO to waive the two-month term after a patent issues for filing an application for patent term adjustment as set forth in 37 CFR §1.705(d). This will allow the applicants to request that the USPTO reconsider their determination of applicants' patent term adjustment in accordance with the interpretation of the applicable Patent Rules and Patent Statute as set forth in the Wyeth v. Dudas decision. It is respectfully submitted that this would be just, since by following the USPTO interpretation set forth in 69 Fed. Reg. 34238 (June 21, 2004), the applicants lost

the right to request additional patent term adjustment of applicants' patent, which is now sought to be remedied.

This situation arises not because of a mistake on the part of the applicants, but rather on the part of the USPTO. It would thus be unfair to deny the relief requested herein.

For the reasons set forth herein, it is respectfully submitted that this is an extraordinary situation where justice requires suspension of the aforesaid two-month term set forth in 37 CFR §1.705(d).

It is noted that Petitions under 37 CFR 1.183 have been granted in the past to provide relief for applicants. Eckey v. Watson, Comr. Pats., 122 USPQ 5 (Ct. Appl. D.C. 1959); Vertesi and Rokop v. Rokop and Gibson, 181 USPQ 734 (Comm. of Pat. 1974); In re Hardee, 223 USPQ 1122 (Comm. Pat. & Trademarks 1984).

B. Background

To mitigate the loss of patent term due to delays during patent prosecution, 35 USC provides for an adjustment of patent terms for certain specified kinds of USPTO delays, i.e., 35 U.S.C. §1.54(b)(1)(A) (37 CFR §1.702(a)) ("A delays") and, regardless of the reason, whenever the patent prosecution takes more than three years, 35 U.S.C. §1.54(b)(1)(B) (37 CFR §1.702(b)) ("B delays").

Recognizing that the protection provided by these separate guarantees might overlap, 35 U.S.C. forbids double-counting: "To the extent that periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed." 35 U.S.C. §1.54(b)(2)(A) (also see 37 CFR §1.703(f)).

C. Specific Reasons Why this is an Extraordinary Situation Where Justice Requires Suspension of a Provision of 37 CFR 1.705(d)

1. At the time of issuance of the above-identified patent on January 1, 2008, the position of the USPTO was that any administrative delay under 37 CFR §1.702(a) (35 U.S.C. §154(b)(1)(A)) overlaps any 3-year maximum pendency delay under 37 CFR §1.702(b) (35 U.S.C. §154(b)(1)(B)), i.e., an applicant gets credit for an "A delay" or for a "B delay," whichever is larger, but never an "A delay" + a "B delay."

The aforesaid position of the USPTO was set forth in 69 Fed. Reg. 34238 (June 21, 2004) as follows:

"the Office has consistently taken the position that if an application is entitled to an adjustment under the three-year pendency provision of 35 U.S.C. §154(b)(1)(B), the entire period during which the application was pending before the Office (except for periods excluded under 35 U.S.C. §154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the

*relevant period under 35 U.S.C.
§154(b)(1)(B) (in determining whether periods
of delay 'overlap' under 35 U.S.C.
§154(b)(2)(A)."* (emphasis added)

2. The Court in Wyeth v. Dudas decided that the aforesaid position of the USPTO as set forth in 69 Fed. Reg. 34238 (2004) was incorrect. In Wyeth v. Dudas, the court held that an "A delay" or an "A period" could be added to a "B delay" or a "B period" to determine patent term adjustment ("PTA"), so long as an "A delay" does not occur on the same calendar day as a "B delay.

3. Under the Wyeth v. Dudas decision, the above-identified patent would be entitled to 296 days of patent term adjustment ("PTA"), in addition to the 585 days of patent term adjustment afforded the applicants based on the "A period." Such additional 296 days of PTA is calculated as follows:

a. Beginning of the 37 CFR §1.702(b) (35 U.S.C.
§154(b)(1)(B)) period ("B Period"): August 20, 2006
Three years after the filing of the above-identified application on August 20, 2003 is August 20, 2006.

b. End of the 37 CFR §1.702(b) (35 U.S.C §154(b)(1)(B)) period ("B Period"): June 12, 2007

The issue date of the above-identified patent is June 12, 2007.

c. Duration of the "B Period": 296 days

The period from August 20, 2006 to June 12, 2007 is 296 days.

d. Possible Overlap of USPTO Delay Periods

Overlap of PTA of the "A Period" and "B Period": zero days.

e. Additional days of PTA according to the Wyeth v. Dudas decision is the aforesaid "B Period," which is 296 days.

The above calculation is shown schematically in the attached Exhibit A.

4. 35 U.S.C. §154(b)(4) provides a 180 day term from the issuance of a patent to seek a reconsideration of the USPTO determination of patent term adjustment in the United States District Court. However, such 180 day term passed before the rendering of the Wyeth v. Dudas decision. Thus, applicants have no remedy in the Courts to request additional days of patent term adjustment.

5. 37 CFR §1.705(d) provides a two-month term for requesting a USPTO reconsideration of its determination of patent term adjustment. However, such two-month term passed before the rendering of the Wyeth v. Dudas decision. Thus, applicants' only remedy to request the aforesaid additional days of patent term adjustment pursuant to the Wyeth v. Dudas decision is if the USPTO grants this Petition to waive the two-month term set forth in 37 CFR §1.705(d), so that applicants can request reconsideration of the USPTO determination of the PTA based on the Wyeth v. Dudas decision.

6. The USPTO filed an Appeal in the U.S. Court of Appeals for the District of Columbia Circuit challenging the District Court's decision in Wyeth v. Dudas. Considering that the U.S. Court of Appeals for the District of Columbia Circuit will affirm the District Court's decision in Wyeth v. Dudas, it is respectfully submitted that equity requires that applicants be afforded a remedy in the USPTO so as to be entitled to a reconsideration of the USPTO determination of patent term adjustment based on the criteria set forth in Wyeth v. Dudas.

7. The fact that applicants' patent issued approximately nine months before the Wyeth v. Dudas decision should not serve to deprive applicants to the same kind of relief under the Wyeth

v. Dudas decision that would be available to other applicants whose patents issued within 180 days of the Wyeth v. Dudas decision, or after the Wyeth v. Dudas decision. It is respectfully submitted that to deny applicants relief by way of suspending the two-month provision set forth in 37 CFR §1.705(d) would be discriminatory and unjust.

D. Patent Term Adjustment Papers Submitted Herewith

Submitted concomitantly herewith are each of the following papers:

APPLICATION FOR PATENT TERM ADJUSTMENT INCLUDING REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT INDICATED IN AN ISSUED PATENT (37 CFR §1.705(d)); and

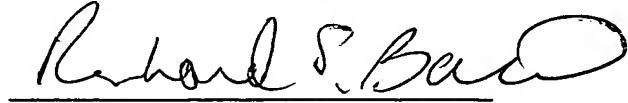
STATEMENT OF THE CORRECT PATENT TERM ADJUSTMENT: BASIS UNDER 37 CFR §1.702 FOR THE ADJUSTMENT (37 CFR §1.705(b)(2)(i) AND (ii)).

E. Fee

Enclosed is a Form PTO-2038 in payment of the \$400 petition fee under 37 C.F.R. §1.17(f) as required by 37 C.F.R. §1.183. If any further fees are required, please charge such fees to Deposit Account No. 06-1378.

It is respectfully requested that this Petition Under 37 CFR §1.183 be granted, so that the application for patent term adjustment appended hereto will be considered by the USPTO.

Respectfully submitted,



RICHARD S. BARTH
REG. NO. 28,180

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RSB/ddf

Encs.: (1) Application for Patent Term Adjustment
 (2) Form PTO-2038 in the amount of \$400
 (3) Exhibit A

Exhibit A

Supplemental
Response to Restriction
Requirement

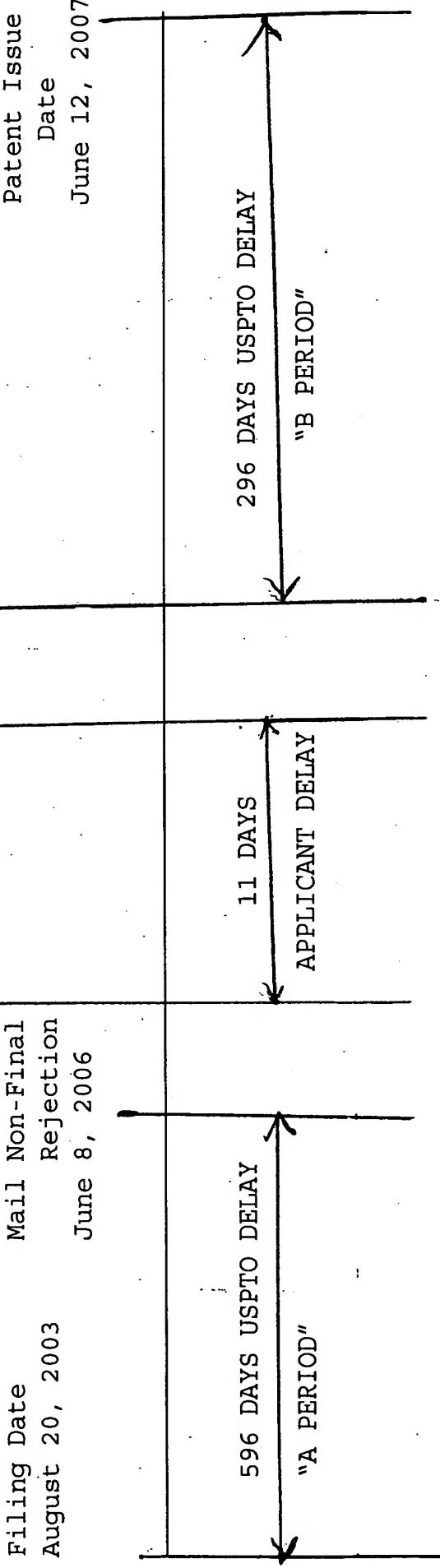
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Response to

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Three Years from
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$$\text{PTA} = \text{A PERIOD} + \text{B PERIOD} - \text{APPLICANT DELAY}$$

$$= 596 \text{ days} + 296 \text{ days} - 11 \text{ days}$$

$$= 881 \text{ days}$$